

Remarks

Claims 1, 2, 6-10 and 13-17 were previously pending in the subject application. By this Amendment claims 2, 6-10 and 14-17 have been cancelled, and claims 1 and 13 have been amended. Accordingly, claims 1 and 13 are now before the examiner for consideration. In order to expedite prosecution, the claims have now been amended to lend greater specificity and clarity to the claimed subject matter. Please note that the claims have been amended in accordance with the applicants' election of certain subject matter to pursue in the current application. These amendments are made solely for the purpose of expediting prosecution and should not be taken to indicate the applicants' agreement with, or acquiescence in, the rejections of record. In view of the amendments to the claims and the remarks below, favorable consideration of the claims now presented is earnestly solicited.

As an initial matter, claim 1 is objected to because of an informality. The Examiner indicates that the claim does not end in a period. The applicants gratefully acknowledge the Examiner's careful review of the claims. By this Amendment, the applicants have amended claim 1 to include a period at the end of the claim to correct the inadvertent clerical error. Accordingly, reconsideration and withdrawal of the objection is respectfully requested.

Claim 17 has been rejected under 35 U.S.C. §112, second paragraph. This claim has now been cancelled thus rendering moot this grounds for rejection.

Claims 1, 2, 6-10 and 13-17 have been rejected under 35 U.S.C. §102(a) as being anticipated by Momol *et al.* (*Phytopathology* 90(6):S127, June 2000) (hereinafter "Momol *et al.* (2000)"). This grounds for rejection is respectfully traversed because the applicants maintain that Momol *et al.* (2000) is not prior art to the claimed invention. As suggested in the outstanding Office Action, the applicants will be submitting a Declaration averring that P.A. Rayside did not contribute to the conception of the claimed invention. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 2, 6-10, and 13-17 under 35 U.S.C. §102(a) as anticipated by Momol *et al.* (2000).

Claims 1, 2, 6-10 and 14-17 have been rejected under 35 U.S.C. §102(b) as being anticipated by Momol *et al.* (Phytopathology 89(6):S54, June 1999) (hereinafter "Momol *et al.* (1999)"). Also, claims 1, 6-10, and 13-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Momol *et al.* (1999). The applicants respectfully traverse this grounds for rejection because the cited reference does not disclose or suggest the advantageous method claimed by the current applicants.

It is basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 718 F.2d 365, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra*; *Kalman [v. Kimberly-Clarke]*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983)] (emphasis added). 221 USPQ at 485.

In *Dewey v. Almy Chem. Co. v. Mimex Co.*, Judge Learned Hand wrote:

No doctrine of the patent law is better established than that a prior patent . . . to be an anticipation must bear within its four corners adequate directions for the practice [of the subsequent invention] . . . if the earlier disclosure offers no more than a starting point . . . if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation. 124 F.2d 986, 990; 52 USPQ 138 (2nd Cir. 1942).

The Momol *et al.* (1999) reference, which was authored by the current applicants, merely describes very controlled greenhouse experiments. In the current case, the claims narrowly recite that a specifically formulated treatment is applied to a tomato plant, or its situs, in the field. Thus, Momol *et al.* (1999) fail to teach each and every element of the claimed invention.

As noted above, for an anticipation rejection to be proper, a single prior art reference must disclose, within its four corners, each and every element of the claimed invention. Further, a reference must be enabling for all that it is being relied upon in making a rejection. In the current case, the Momol *et al.* (1999) reference does not pertain to field applications, provides few details as to how the treatments were applied, and provides no teachings as to how the treatments were formulated. Specifically, the Momol *et al.* (1999) reference does not disclose the use of a composition comprising thymol, ethanol and a detergent to treat field tomatoes. Thus, in accordance with long-established legal precedent, an anticipation rejection is not proper.

Accordingly, the applicants respectfully request reconsideration and withdrawal of the prior art rejection of claims 1, 2, 6-10, and 14-17 under 35 U.S.C. §102(b) as being anticipated by Momol *et al.* (1999).

With regard to the issue of obviousness, nothing in the Momol *et al.* (1999) reference would have led the skilled artisan to the advantageous method claimed by the current applicants. Momol *et al.* (1999) only refer, in very general terms, to tests conducted in very controlled conditions that do not approximate field conditions.

Because the Momol *et al.* (1999) reference only discloses treatment of plants under artificial conditions (*i.e.*, small pot experiments in a greenhouse), there is no way of knowing whether such treatment would be successful on plants growing in field conditions. Also, as noted above, the Momol *et al.* (1999) reference does not disclose the advantageous formulation claimed by the current applicants. Thus, it cannot be stated that an observation of some undisclosed level of *in vitro* or greenhouse activity achieved with an undefined formulation would make it obvious that a particular pathogen could be controlled with a specific formulation on plants in the field.

A finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, it is only the applicants' disclosure that provides such a teaching, and the applicants' disclosure cannot be used to reconstruct the prior art for a rejection under 35 U.S.C. §103. This was specifically recognized by the CCPA in *In re Spinnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

The mere fact that the purported prior art could have been modified or applied in a manner to yield applicant's invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art" *In re Dow Chemical Co., supra* at 1531. In *Momol et al.* (1999), one finds neither. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 2, 6-10, and 13-17 as obvious in view of *Momol et al.* (1999).

In view of the foregoing remarks and the amendments above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



David R. Saliwanchik
Patent Attorney
Registration No. 31,794
Phone: 352-375-8100
Fax No.: 352-372-5800
Address: 2421 N.W. 41st Street, Suite A-1
Gainesville, FL 32606-6669

DRS/la

Attachments: Marked-up Version of Substitute Claims; and
Petition and Fee for Extension of Time

Marked-up Version of Substitute Claim AmendmentsClaim 1 (twice amended):

A method for controlling [a] *Ralstonia solanacearum* [plant pathogen on a plant] wherein said method comprises applying to [said] a field-grown tomato plant or its situs a pesticidally effective amount of [a plant essential oil] a composition comprising thymol, ethyl alcohol and a detergent.

Claim 13 (amended):

The method, according to claim 1, wherein said [essential oil] composition is applied as a fumigant.